REMARKS

The present application includes pending claims 1-28, all of which have been rejected. Reconsideration of the claim rejections is requested.

I. Support In The Specification For "Simplex Power Receptacle Having A Respective Housing"

The drawings were objected to under 37 CFR 1.83(a) because they allegedly do not show each simplex power receptacle having a respective housing. Additionally, claims 1-17 and 21-27 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The Office Action contends the following:

> By adding that the invention may "each simplex power receptacle having a respective housing" the amended claim involves a departure from the disclosure of the application as filed. Therefore, the subject matter claimed in claims 1-17 and 21-27, detailing the entire scope of the invention, is not described in the application.

April 19, 2005 Office Action at page 2.

Additionally, the specification is objected to for allegedly failing to provide proper antecedent basis for the claimed subject matter. Again, the Office Action focuses on "simplex power receptacle having a respective housing," as not being supported by the original disclosure. *See id.* at page 4. The amendment filed on June 14, 2004 is also objected to under 35 U.S.C. 132 because it allegedly introduces new matter, for the same reasons noted above. *See id.* at page 5. The Applicants note that subsequent to

the June 14, 2004 amendment, the Applicants responded to three separate office actions , in which none of the above rejections/objections were made.

The Applicant respectfully traverses the objection to the drawings, the rejection under 35 U.S.C. 112, first paragraph, the objection to the specification, and the assertion that the June 14, 2004 Amendment added new matter, at least for the reasons set forth hereafter.

A. Compact Prosecution

Initially, the Applicants note that a goal of patent examination is to provide a prompt and complete examination of a patent application.

> It is essential that patent applicants obtain a prompt yet complete examination of their applications. **Under the principles of compact prosecution, each claim should be reviewed for compliance with every statutory requirement for patentability in the *initial review* of the application**, even if one or more claims are found to be deficient with respect to some statutory requirement. **Thus, Office personnel *should* state *all* reasons and bases for rejecting claims in the *first* Office action.** Deficiencies should be explained clearly, particularly when they serve as a basis for a rejection. Whenever practicable, Office personnel should indicate how rejections may be overcome and how problems may be resolved. A failure to follow this approach can lead to unnecessary delays in the prosecution of the application.

Manual of Patent Examining Procedure (MPEP) § 2106(II) (emphasis added). As such, the Applicants assume, based on the goals of patent examination noted above, that the current claim objections and rejections now reflect "all reasons and bases" for rejecting the claims, despite the fact that these objections and rejections are different than those delineated in previous office actions.

In general, however, the Applicants are surprised at the new objections and rejections only now being set forth. The current Office Action is the **fifth** substantive office action received from the Examiner. Only in this **fifth** Office Action has the Examiner raised these various issues regarding the rejections and objections noted above. Clearly, this runs afoul of the "principles of compact prosecution," as noted above, and poses various inconveniences to the Applicants, both in terms application pendency, and costs related to prosecution.

B. A "Simplex Power Receptacle Having A Respective Housing" Is Clearly Disclosed In The Original Disclosure

The Applicants are confused by the rejections and objections noted above because a "simplex power receptacle having a respective housing" is clearly disclosed in the original disclosure. A simplex power receptacle having a respective housing is clearly shown, for example, in Figure 9 of the present application, which is reproduced below.

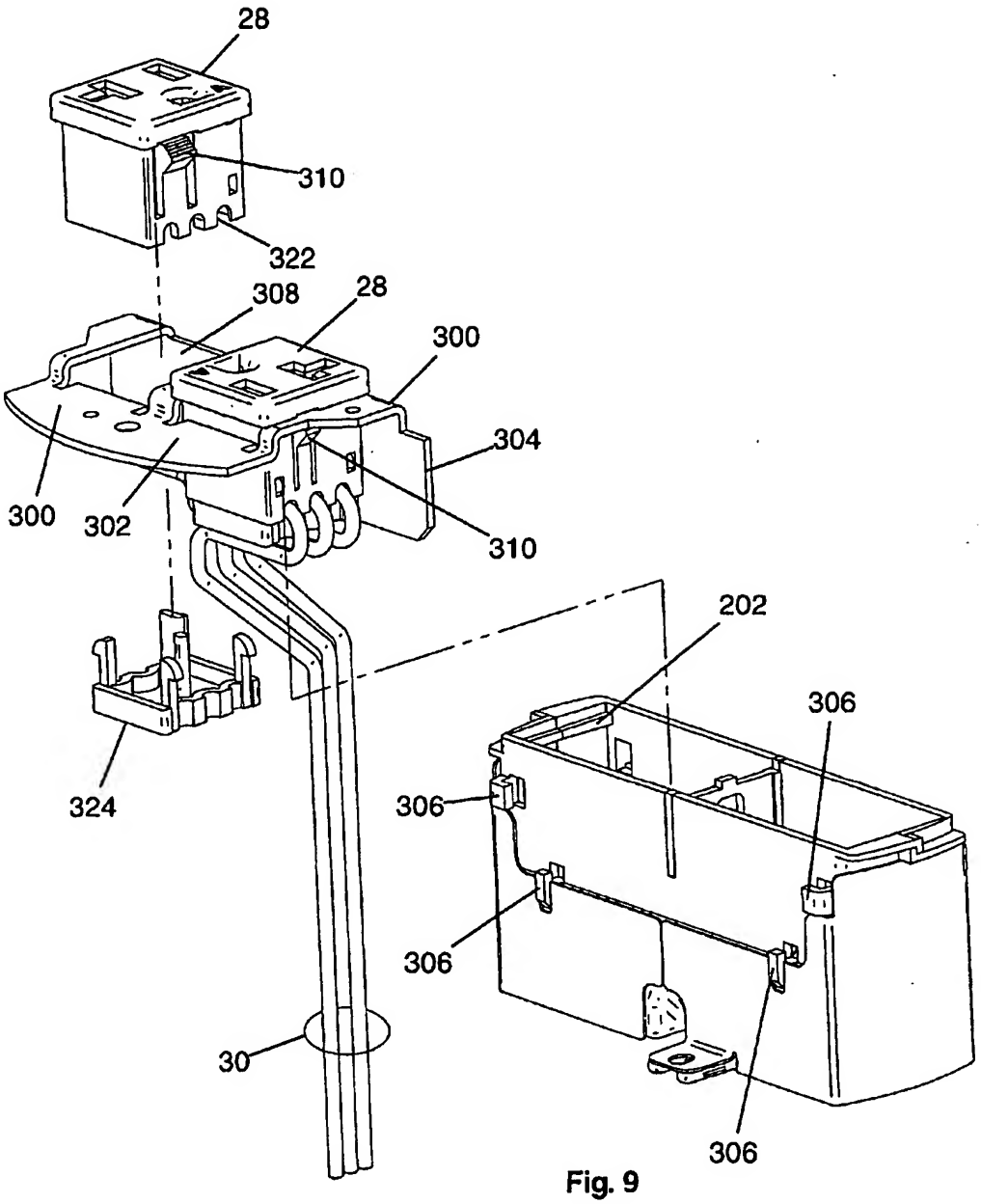

Fig. 9

The simplex power receptacle having its own respective housing is clearly shown by reference numeral 28. Clearly, the simplex power receptacle is a single, unitary receptacle having its own housing, as shown above. In fact, ¶ [62] of the present application reads as follows:

> The electrical receptacles 28 **are in the form of simplex receptacles** which are configured to snap into mounting apertures 308 formed in the top plate 302 of the power receptacle mounting brackets 300. For this purpose, the **housing of the power receptacle** 28 includes a pair of opposing locking tabs 310 that extend outwardly from the housing.

See specification of present application at ¶ [62]. The Applicants respectfully submit that a "simplex power receptacle having a respective housing" is clearly shown and described in the present application. In fact, the Applicants cannot fathom a more concise and clear description of a simplex power receptacle having its own housing than that shown and described above. As such, the Applicants respectfully request reconsideration of the following: the objection to the drawings, the rejection under 35 U.S.C. 112, first paragraph, the objection to the specification, and the assertion that the June 14, 2004 Amendment added new matter.

II. The Rejection Of Claims 1-28 Under 35 U.S.C. 103

Claims 1-28 were rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent No. 6,417,446 ("Whitehead") in view of United States Patent No. 4,952,163 ("Dola") and United States Patent No. 4,952,163 ("Norsworthy"). The Applicants respectfully traverse this rejection, at least for the reasons set forth below.

A. There Is No Motivation To Combine Whitehead With Dola And Norsworthy

In order for a *prima facie* case of obviousness to be established, the Manual of Patent Examining Procedure (MPEP) states the following:

> First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the teaching. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art.

See MPEP MPEP § 2142. Additionally, if a *prima facie* case of obviousness is not established, the Applicants are under no obligation to submit evidence of nonobviousness.

> The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.

See id.

1. Whitehead Relates To A Poke-Through Device

Whitehead discloses a "poke-through device for installation in a hole extending through a concrete floor structure of a building." *See* Whitehead. Whitehead discusses that the size of a poke-through device is limited by the floor opening into which it is positioned.

> [P]roblems still remain with the use of poke-through devices. Once such problem involves the **limited number of electrical interfaces** provided by the prior art devices. It will

> be recognized that the size of the hole which may be drilled through a concrete floor is limited by the structural characteristics of the floor. Typically, **building codes allow the drilling of a hole having a diameter between about two and four inches, which thus limits the maximum size of the poke-through device**. However, even utilizing the mentioned four inch diameter hole, prior art devices only provide a **limited number of electrical interfaces**. For example, a single prior art poke-through device typically provides only a two-plug arrangement.

Whitehead at column 1, lines 50-62 (emphasis added). *See also id.* at column 4, line 65 to column 5, line 3 ("Inasmuch as floor structure 14 is typically a structural, load bearing member of the building, the maximum size of the interfloor is **limited by building code requirements**. In particular, interfloor holes, typically range in diameter from two to four inches.").

Whitehead clearly recognizes the difficulties of trying to maximize electrical applications on the limited area of a poke-through, the size of which is dictated by a corresponding floor opening. As such, Whitehead discloses specific designs intended to maximize such capabilities. In particular, Whitehead discloses the following:

> The device provides a four-plug arrangement, together with two data connection jacks, all located in a concealed manner. The device alternatively provides a two-plug arrangement, together with four data connection jacks. An additional alternative embodiment provides an arrangement having six data connection jacks.

Whitehead at Abstract. Notably, Whitehead only discloses those three embodiments. In short, Whitehead's embodiments attempt to maximize use of the limited space on a poke-through by the three disclosed embodiments. Introducing additional bulky or even optional materials into the limited space of Whitehead's poke-throughs, however, would increase their sizes, thereby precluding them from being used in constrained spaces (e.g., four inch holes, which are mandated by building codes, as noted above).

To maximize the space on a poke-through surface, Whitehead discloses specific embodiments that allow for three different arrangements, as noted above in the Abstract of Whitehead. In particular, Whithead discloses specific wedge-shaped electrical duplexes, or, alternatively, a bow-tie configuration.

> As shown, the receptacles are preferably formed as separate wedge-shaped units, each including two electrical outlets. The electrical outlets, i.e., outlets 114, are configured for receipt of conventional 110 voltage electrical plugs. Of course, the outlets may be configured for receipt of various other electrical plugs. Alternatively, the receptacle may be formed as a single "bow-tie" shaped four-plug unit (receptacle 98').

Id. at column 6, line 63 to column 7, line 3. In an effort to maximize the space on the poke-through, Whitehead only discloses the use of the specific wedge-shaped duplex receptacles, or the bow-tie quad receptacle. Adding or substituting other receptalces would add size to Whitehead's poke-through, and therefore make it unusable for its intended purpose. With that in mind, the Applicants now turn to Dola and Norsworthy.

2. Dola Cannot Be Combined With Whitehead

Initially, the Applicants note that a "prior art reference **must** be considered in its **entirety**, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP at 2141.02.

Dola relates to a "raceway assembly employing snap-on outlet covers." *See* Dola at Abstract. "The raceway has multiple compartments extending longitudinally for carrying conductors such as standard house wiring power conductors and telephone or data conductors." *Id.*

> This invention relates to a raceway assembly which can be employed with power conductors and telephone or data conductors and can be mounted **either inlaid in a wall or along the surface of a wall or panel**. More particularly, this invention relates to a outlet or a receptacle housing which can be employed with a raceway containing a plurality of compartments, each compartment containing a unique set of wires, such as power, telephone or data conductors.

Id. at column 1, lines 9-17 (emphasis added). Dola relates to a raceway assembly that may be mounted or secured within or on walls. The raceways may extend over long distances. In general, the raceways disclosed in Dola are not restricted by the same space constraints as the poke-through device disclosed in Whitehead. As such, the raceways in Dola may utilize additional and bulkier components than the three embodiments disclosed in Whitehead.

As noted above, Whitehead discloses specific wedge-shaped duplexes or bow-tie quads to maximize the limited space within the poke-through. Picking and choosing an isolated element from Dola and attempting to shoehorn into the poke-through device disclosed in Whitehead, however, would add size and bulk to the poke-through device, thereby making it too large to adequately mount into a floor opening.

"In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is **not** whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP at 2141.02. The law is well settled that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so." *ACS Hospital Systems, Inc. v. Montfiore Hospital*, 732 F.2d 1572, 1577, 221 USPQ 929 (Fed. Cir. 1984). It is not permissible to pick and choose among the individual elements of assorted prior art references to re-create the claimed invention, but rather "some teaching or suggestion in the references to support their use in the particular claimed combination" is needed. *Symbol Technologies, Inc. v. Opticon, Inc.* 935 F.2d 1569, 1576, 19 USPQ2d 1241 (Fed. Cir. 1991).

To summarize, adding Dola to Whitehead ignores the references as a whole. There simply is no teaching or suggestion in Whitehead to use any of the bulky components from Dola, which is not concerned with the space-constraining considerations of Whitehead. As such, the Applicants respectfully submit that there is no motivation or suggestion to combine Whitehead with Dola.

3. Norsworthy Cannot Be Combined With Whitehead

Norsworthy "relates to an electrical distribution box for use in a utility electrical distribution system." Norsworthy at column 1, lines 4-5. Norsworthy discloses a "power distribution box comprising a substantially closed casing having first and second interior compartments." *Id.* at Abstract. The box disclosed in Norsworthy is a bulky modular device that is used for electrical distribution.

> There exists a very substantial need for an electrical distribution system for use in areas where temporary distribution of electrical power is required. The need has been particularly acutely felt where larger outdoor systems are required. Typical examples are at construction sites, military bivouac areas, runways and helicopter landing pads.

Id. at column 1, lines 8-14. Norsworthy does not discuss any need for minimizing the size of its distribution box. In fact, space constraints simply are not an issue for the modular system of Norsworthy. *See id., e.g.,* at column 4, lines 15-18 ("A carrying handle is preferably located on the top of the box and the bottom of the box is preferably recessed to accommodate the handle of a lower box **to facilitate stacking**."). Norsworthy uses bulky components that could not fit into the limited space of Whitehead's poke-through. For example, the bulky receptacle housings shown in Norsworthy could not fit into the limited space of the poke-through shown in Whitehead. The large, bulky receptacles shown in the mobile power distribution box would add too much size to the poke-through of Whitehead, thereby precluding it from fitting into appropriate floor openings.

"In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is **not** whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." MPEP at 2141.02. As mentioned above, the law is well settled that "obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so." *ACS Hospital Systems,* 732 F.2d at 1577. It is not permissible to pick and choose among the individual elements of assorted prior art references to re-create the claimed invention, but rather "some teaching or suggestion in the references to support their use in the particular claimed combination" is needed. *Symbol Technologies, Inc.,* 935 F.2d at 1576.

In sum, adding Norsworthy to Whitehead ignores the references as a whole. There simply is no teaching or suggestion in Whitehead to use any of the bulky components from Norsworthy, which is simply not concerned with the limited space considerations of Whitehead. In fact, Whitehead specifically teaches away from being combined with the bulky components of the "on-floor" distribution box of Norsworthy. For example,

> Much activity has been devoted to avoiding the necessity of using on-floor conduits for conveying electrical power and communication lines to floor locations which were not within the original architectural and electrical planning of a facility, such as a multi-floor concrete building. Such on-floor conduits are unsightly and may also pose a safety hazard to persons working in such area.

Whitehead at column 1, lines 8-15. As such, the Applicants respectfully submit that there is no motivation or suggestion to combine Whitehead with Dola.

4. The Office Action Merely Picks And Chooses Isolated Elements From Disparate References

The Applicants respectfully submit that attempting to pick and choose single isolated elements from Dola and Norsworthy and shoehorn them into Whitehead ignores the references in their entireties and is therefore improper. There simply is no suggestion in these references to combine them to arrive at the invention recited in the claims of the present application. Even if one assumed that the combination did teach the limitations recited in the claims, there simply is no motivation to combine these references.

In *Ex parte Hiyamazi*, the Board of Patent Appeals and Interferences reversed a rejection based on a combination of references, stating, in part:

> Under 35 USC § 103, where the Examiner has relied upon the teachings of several references, the test is whether or not the reference viewed individually and collectively would have suggested the claimed invention to the person possessing ordinary skill in the art. Note *In re Kaslow*, 707 F.2d 1366, 107 USPQ 1089 (Fed.Cir. 1983). **It is to be noted, however, that citing references which merely indicate the isolated elements and/or features recited in the claims are known is not a sufficient basis for concluding that the combination of claimed references would have been obvious.** That is to say, there should be something in the prior art or a convincing line of reasoning in the answer suggesting the desirability of combining the claimed invention. Note *In re Deminski*, 796 F.2d 436, 230 USPQ 313 (Fed.Cir. 1986).

Ex parte Hiyamazi, 10 USPQ2d 1393, 1394 (Bd. Pat. App. & Interf. 1988) (emphasis added).

In combining Whitehead, Dola, and Norsworthy, the Office Action has merely picked and chosen among isolated, individual elements of separate references to re-create the Applicants' claimed invention. There is no teaching or suggestion in these references to support their use in the particular claimed combination. The proposed combination represents "the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher." *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 1553, 220 USPQ 303, 313 (Fed.Cir. 1983). Thus, at least for these reasons, the Applicants respectfully submit that the claims of the present application should be in condition for allowance.

B. The Claims Of The Present Do Not Merely Duplicate Essential Working Parts

The claims of the present application do not "merely duplicate the essential working parts" of the embodiments shown in Whitehead or the other two references, as suggested in the Office Action.

For example, with respect to claim 6, the cited references do not disclose or suggest a poke-through fitting that includes both four simplex power receptacles and four data jacks. Nor would it be obvious to so modify these references given the space constraints imposed on poke through fittings. Specifically, as noted in Whitehead, building codes typically restrict such fittings to a maximum diameter of four inches.

> Inasmuch as floor structure 14 is typically a structural, load bearing member of the building, the maximum size of the interfloor is limited by building code requirements. In particular, interfloor holes, typically range in diameter from

two to four inches. In one preferred embodiment, hole 12 is formed with a four inch diameter.

Whitehead at col. 4, line 65 to col. 5, line 3. Designing systems that accommodate the maximum number of components in a limited space is simply not merely duplicating working parts. Hence, the claims of the present application are believed to be patentable over the cited references, at least for this reason.

III. Conclusion

In view of the above, claims 1-28 are believed to be in condition for allowance. The Examiner is invited to telephone the Applicants' undersigned attorney at (312) 775-8000 if any unresolved matters remain. Please charge any fees due in connection with this submission to Deposit Account No. 13-0017.

Respectfully submitted,

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